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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): PRKR-4600

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 16, 2007

Signature _____

Typed or printed name Maria Cefalu

Application Number	Filed
10/775,039	02/09/2004

First Named Inventor: KEVIN P. PARKER

Art Unit	Examiner
3651	Nicholson III, Leslie August

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s). (sheets 1-4 attached)
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [X] attorney or agent of record. Registration number 28,848
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

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November 16, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

Reasons for Requesting Review

[Application No. 10/775,039 filed 02/09/2004]

The Invention

As described in detail in the subject application, the present invention relates to apparatus and methods for conditioning sheets, particularly coated papers such as used in photography, so that the sheets can be reliably bound using conventional heat activated adhesive binder strips. The invention also relates to the conditioned sheets themselves.

As noted at page 2, line 22 et seq of the subject application, Applicants have found that the approach disclosed in USPNo. 5,961,268 (prior art of record) to texturize the edge of the stack of sheets using a rotating wire brush prior to binding was not satisfactory for coated sheets. As also noted, neither was milling the stack edge using a conventional milling apparatus that grinds or mills the stack edge to be bound.

Applicants have found that subjecting stacks of sheets to a certain piercing action as set forth in allowed method Claims 26, 28, 44 and 58 permits such sheets, even if in the form of coated paper, to be reliably bound using conventional binder strips. As can be seen schematically by the conditioned stack 70 of Fig. 10 of the drawings and by the conditioned individual sheets 70A of Figs 11A, 11B and 11C, the claimed conditioning action functions to split the edges of the individual sheets to form true splits 72 and 72A (Figs 10 and 11A) and, in some cases, exposed surfaces 72B (Figs 11B and 11C).

Claims 27, 29, 45 and 58 at issue here are product-by-process claims directed to sheets made in accordance with respective allowed method Claims 26, 28, 44 and 58. All of these claims are set forth in the "Response to Office Action Mailed on January 17, 2007" which was mailed on June 12, 2007 (hereinafter "Response A").

As an aside, these product-by-process claims were objected to on the grounds that they are improper dependent claims – Applicants have filed to petition to address this issue.

The Rejections of Claims 27, 29, 45 and 58

Prior Art Rejections – the claims were all rejected for being anticipated under §102 or alternatively rendered obvious under §103 in view of either USPNo. 2,646,726 to Fogg (hereinafter Fogg) or USPNo. 1,642,866 to Ackely (hereinafter Ackely) as set forth at page 4 of the Office Action mailed on January 17, 2007 (hereinafter "Action A") and pages 2 and 5 of the Office Action mailed on July 16, 2007 (hereinafter "Action B"). These prior art rejections make no reference to the sheet structure implied by the recited methods as required by MPEP 2113 and further provide no reasoning whatsoever as to why no patentable weight is being given to such structure.

§112 Rejections – the claims were further rejected under the first paragraph of §112 for "failing to comply with the written description requirement" and because of a "non-enablement problem" (pages 3 and 4 of Action A). According to the Examiner, the specification provides support only for "conditioning the edge of a stack of sheets", with the [p]rocess of conditioning a single sheet as claimed" not being supported". (pages 3 and 4 of Action A)

Applicants' Response to the Rejections

Prior Art Rejections The Examiner is making *clear error* for failing to give any patentable weight whatsoever to the structure implied by the process for making the sheets as required by MPEP 2113 and the cases cited in that section. As noted in detail in Response A, starting at page 17 and continuing

through page 20, the sheets made in accordance with the methods of Fogg and Ackley differ structurally from the claimed sheets. Further, the Fogg and Ackley sheets do not render the claimed sheets obvious. Nowhere has the Examiner responded to these arguments other than effectively stating - "See MPEP 2113".

§112 Rejections Applicants were unable to ascertain from the wording of these rejections whether they were based upon lack enablement, lack of a written description or both. See pages 17 to 18 of "Response to Final Rejection Mailed on July 16, 2007 and Request for Interview" (the interview was not granted) mailed on July 30, 2007 (hereinafter Response B). In any event, as pointed out in Response B at page 18, Applicants are not claiming a method of conditioning a single sheet as set forth in the rejection described above, but are claiming a sheet made in accordance with a method of conditioning a stack of sheets.

With respect to any lack of enablement, Applicants believe that if a conditioned stack of sheets is enabled, so is a conditioned sheet. It is *clear error* for the Examiner to take the position that one of ordinary skill in the art is unable to remove a single sheet from a stack of sheets. Note also that Applicants have proposed rewording the rejected claims to read " a sheet from a stack conditioned in accordance with the method of Claim ..." (see page 18 of Response B) but there was no response from the Examiner.

With respect to the alleged lack of a written description, the subject application describes the positive binding attributes in terms of the characteristics of the individual sheets of the conditioned stack. It is usually an individual sheet that falls out of a bound stack due to lack of proper conditioning of the individual sheet. Each of the method Claims 26, 43 and 58 from which the rejected claims depend (either directly or indirectly) makes some reference to each sheet of the stack being engaged in the conditioning process. Moreover, Applicants (see page 17 of Response A) have identified several instances in the application as filed where reference is made to the characteristics of a single

sheet, and instances where single sheets are depicted in the drawings, including the following:

> "Figs 11A, 11B and 11C how more typical examples of individual sheets of a stack that has been conditioned in accordance with the present invention." [page 11, line 19 et seq of Application – emphasis added.]

In response, the Examiner has stated that "[t]he passages and figures cited by the Applicant show a sheet that is in a stack of sheets." [page 2 of Action B]. Applicants assert that a description of a conditioned stack of sheets and a description of the individual conditioned sheets, regardless of whether such sheets are present in a stack, provide more than adequate descriptive support for the rejected claims. It is *clear error* on the part of the Examiner to find otherwise in view of the forgoing.

In conclusion, the rejections represent clear error on the part of the Examiner and should be reversed.

Respectfully submitted,
GIRARD & EQUITZ LLP

Dated: Nov. 16, 2007 By: _____

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Attorneys for Applicant(s)

Attorney Docket No. PRKR-4600